UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte TERRY P. SNUTCH
and DAVID L. BAILLIE

Appeal No. 2006-2389
Application No. 09/346,794

ORDER

Before SCHEINER, MILLS, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

ORDER

This appeal has been set for oral hearing on October 19, 2006. The rejections on appeal are based on lack of utility under 35 U.S.C. §§ 101 and 112, first paragraph.

In addition to the rejections for lack of utility, the panel would like to discuss the following issues at the oral hearing:

The claims on appeal are directed to a method of identifying agonists and antagonists of a T-type calcium channel, using "[an] α_1 subunit . . . functional as a T-type calcium channel and . . . encoded by a nucleotide sequence which hybridizes under [specified] conditions of stringency . . . to a nucleic acid comprising SEQ ID NO:23." The specification states that SEQ ID NO:23 is full-length cDNA that encodes

the rat α_{1G} subunit of a T-type calcium channel. Page 16, lines 1-11. SEQ ID NO:23 is 7540 nucleotides long.

According to Appellants, the present application is "a continuation-in-part of copending U.S. Patent Application . . . Serial No. 09/030,482, filed February 25, 1998." Specification, page 1. The parent '482 application states that it "provides partial sequences for a novel mammalian (human and rat sequences identified) calcium channel subunit which we have labeled as the α_{1I} subunit, and an additional novel human calcium channel which we have labeled as the α_{1H} subunit." Page 8, lines 2-4 (emphases added).

The '482 application does not appear to disclose nucleotide sequences encoding an α_{1G} subunit, and none of the sequences in the '482 application's Sequence Listing is 7540 nucleotides in length. Therefore, the claims on appeal – which require use of a nucleotide sequence encoding an α_{1G} subunit that hybridizes to SEQ ID NO:23 – would not appear to be supported by the earlier application in the manner required by 35 U.S.C. § 112, first paragraph. If they lack such support, the present claims are not entitled to the benefit of priority under 35 U.S.C. § 120 based on the earlier-filed application. The present application was filed July 2, 1999.

The Information Disclosure Statement filed March 15, 2001 includes, among others, the following reference: Perez-Reyes et al., WO 99/29847, published June 17, 1999. Perez-Reyes discloses "the amino acid sequences of full-length T-type channels, and the sequences of suitable coding nucleic acids . . . at SEQ ID NOs:1-8 (α1G sequences)." Page 6, lines 5-7. Perez-Reyes indicates that SEQ ID NO:5 is derived from rat ("Rattus sp."). See page 37. Amino acids 33-2254 of the sequence encoded

by Perez-Reyes' SEQ ID NO:5 appear to be virtually identical to amino acids 65-2287 of the sequence encoded by SEQ ID NO:23 of the present application.

Perez-Reyes discloses a

> method of identifying a drug which affects T-type calcium channels. The method involves first expressing a T-type calcium channel in a cell to produce an active channel. . . . The cell expressing the channel is then exposed to a solution containing a putative drug for interfering with the channel. Thereafter, the presence or absence of calcium flux in response to a change in membrane potential is assayed.

Page 11, lines 7-12. Perez-Reyes also includes a working example showing that "mibefradil almost completely abolished T-type current in cells expressing α1G." Page 18. The example is said to "demonstrate[ ] that a cloned T-type calcium channel can be used for identifying a drug which affects T-type calcium channels." Id.

Accordingly, it is ordered that Appellants' representative be prepared to discuss at the oral hearing on October 19, 2006:

(a) the effective filing date of the claims on appeal,

(b) whether Perez-Reyes qualifies as prior art with respect to the claims on appeal, and

(c) whether the disclosure of Perez-Reyes anticipates or would have made obvious any of the claims on appeal.

Toni R. Scheiner
Administrative Patent Judge

Demetra J. Mills
Administrative Patent Judge

Eric Grimes
Administrative Patent Judge

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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040